

### REMARKS

The Advisory Action dated December 13, 2006 indicates that the proposed amendments filed after the final rejection will not be entered because they raise new issues that would require further search and consideration. Applicant is puzzled by this assertion because the amendment proposed for claim 1 includes the verbatim limitations of original claim 8.

In any case, claims 1-12 were pending in this application. As previously proposed, claim 1 has been amended by incorporating the limitations of claim 8 therein. Accordingly, claim 8 has been cancelled. Claim 1 has been further amended to require that the rigid yet manually deformable characteristic of the rail is present "in the absence of any assembly of the rail with the fencing system". Support for this limitation can be found in paragraph [0019] of the specification. Specifically, the ability of the rail to be rigid yet manually deformable in the absence of any assembly thereof with the fencing system is inherent in the construction of the rail (e.g., metal wires ensheathed in plastic). This rigid and manually deformable characteristic out of the context of the rail is evidenced by the rail being rigid enough that, "when a section of it is placed on an edge of a tabletop, it is self-supporting." Accordingly, no new subject matter has been added by this amendment.

Therefore, claims 1-7 and 9-12 remain in this application.

### 35 U.S.C. §103 Rejections

Claims 1-12 stand rejected under 35 U.S.C. §103(a) for obviousness based upon the Safe-Fence reference in view of the Johnson patent. The Examiner asserts that although the Johnson patent may not be analogous art, it is nonetheless reasonably pertinent to the particular problem with which the inventor was concerned, and therefore it may still be relied upon as a basis for rejection (*In re Oetiker*, 997 F.2d 1443 (Fed. Cir. 1992)). The Examiner asserts that the teachings of the Johnson patent (i.e., constraining function) are pertinent to solving the problem of constraining the fence rail in the slotted connector. Therefore, the Examiner insists that the Johnson patent may still be relied upon in his rejection.

However, Applicant wishes to point out that the Examiner has not further inquired into the interpretation of the “reasonably pertinent” aspect of the test offered in *Oetiker*. According to the relevant case law, a “reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem” (*Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993)). The Johnson patent is clearly “in a different field from that of the inventor’s endeavor.” An inventor attempting to secure a fence rail would not have looked at the art of wrapping a box or other package via strapping, but rather to the field of fencing. As support for this assertion, for example, the Johnson buckle is a single buckle used to connect two opposite ends of a strap to opposing ends of the buckle to encircle the box. This is in contrast to how the current invention works – a slotted connector for securing a rail to a post. Another slotted connection is then required to connect the free end of the rail to another post. In view of the aforementioned case law and the application of law in those cases, Applicant believes that the Examiner is clearly wrong as a matter of law in his reliance on the Johnson patent to reject the pending claims. The Examiner’s reference to the Johnson patent appears to arise from impermissible hindsight.

The Johnson buckle is used to connect two opposing ends of a non-rigid strap around a package. Therefore, the Johnson patent deals with (a) wrapping packages (not fencing); and (b) a buckle for securing a non-rigid strap, as opposed to a rigid fence rail. Furthermore, the present invention does not require friction engaging roughened surfaces as in the Johnson invention. It has been held that absent a suggestion to combine the references, an Examiner can do no more than piece the invention together using the patented invention as a template – such hindsight reconstruction is impermissible (*Texas Instruments Inc. v. U.S. Intern. Trade Com’n.*, 988 F.2d 1165, 1178 (Fed. Cir. 1993)). It is Applicant’s view that the Examiner is using improper hindsight to pick and choose a piece of the Johnson patent out of context from the other features that the Johnson patent discloses.

Amended claim 1 requires that the rail be “rigid, yet manually deformable.” As set forth on the bottom of page 4 of the Final Office Action, the Examiner has indicated that this limitation is met by Safe-Fence in the instance “when the rail is assembled with the

connector and is pulled taut.” However, the interwoven polymeric webbing polytape in Safe-Fence cannot in and of itself be construed as being rigid, let alone manually deformable. The Installation printout of Safe-Fence previously provided by the Examiner specifically states that one should be careful to “not over-stretch [the] polytape.” This indicates that the tape is not a rigid material. Furthermore, one needs to “hand-tighten [the poly-tape] to eliminate sagging between fence posts.” This indicates that the poly-tape cannot be manually deformed while still retaining its rigidity. The Examiner is construing the aforementioned limitation in the context of an installed tape. The installed tape is simply not “rigid, yet manually deformable” given the plain meaning of such wording. This fundamental difference is further pointed up by the fact that, by its own terms, the Safe-Fence reference describes the device as a “tensioner” or a “spring buckle”, not a “connector” as required by claim 1.

The invention of claim 1 is not a “tensioner” or a “spring buckle”. Unlike the rail of claim 1, the Safe Fence reference requires the bent rod tensioner device, because the webbing therein is not self-supporting. The bent rod device in Safe-Fence flexes to tension or de-tension the webbing. The connector of claim 1 performs no such function.

The Federal Circuit reviewed an application in which the claim related to an athletic shoe with cleats that “break away at a preselected level of force” and thus prevent injury to the wearer. The examiner rejected the claims over prior art teaching athletic shoes with cleats not intended to break off and rationalized that the cleats would break away given a high enough force. The court reversed the rejection stating that when interpreting a claim term which is ambiguous, such as “a preselected level of force”, we must look to the specification for the meaning ascribed to that term by the inventor. The specification had defined “preselected level of force” as that level of force at which the breaking away will prevent injury to the wearer during athletic exertion (*In re Weiss*, 989 F.2d 1202, 26 USPQ2d 1885 (Fed. Cir. 1993)).

For the same reasons as discussed in *Weiss*, one must look to the specification of the application in the instant case. Paragraph [0019] describes the rail as having a construction that is “conducive to manual deformation of the rail, yet retaining a high degree of stiffness in the rail. It is to be understood that any other type of rail fencing exhibiting stiffness and deformability qualities inherent in composite metal and plastic web fencing may

also be utilized. For example, in the preferred embodiment, the rail is rigid enough that, when a section of it is placed on an edge of a tabletop, it is self-supporting.” The aforementioned description of the rail, whether in the preferred embodiment or otherwise, all refer to the rail itself being inherently rigid. Therefore, the “rigid, yet manually deformable” limitation cannot be equated to the Safe-Fence tape being in an assembled and pulled-taut state.

In any case, to further define the rail of the claimed invention over the Safe-Fence tape, Applicant has amended claim 1 to require that the rail is rigid yet manually deformable in the absence of any assembly thereof with the fencing system. Thus, the Examiner’s argument that the Safe-Fence tape meets the limitation of “rigid yet manually deformable” when it is pulled taut is now clearly incorrect.

Since the Johnson patent is non-analogous art and the added limitation relating to the rail being rigid, yet manually deformable in the absence of assembly, Applicant believes that the subject matter of the pending claims is not rendered obvious by the Safe-Fence reference in view of the Johnson patent.

As to claim 2, the claimed invention requires edges on the connector which are return edges, extending perpendicularly from the face plate. These return edges provide the additional feature of protecting livestock from the edges of the rail, which might otherwise (especially when the rail edge is damaged or frayed) cause injury to the livestock. This problem is clearly not contemplated or addressed by either the Safe-Fence reference or Johnson. Johnson appears to neither teach nor suggest such return edges, and in fact Johnson teaches away from this limitation (see Johnson, Figs. 1-9). The return edges also help align the rail to the connector during and after installation to further protect against injuring livestock and to prevent the rail and connector from becoming askew with respect to one another.

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**CONCLUSION**

Based on the foregoing amendments and remarks, reconsideration of the rejections and allowance of pending claims 1-7 and 9-12 are respectfully requested.

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